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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,490	10/31/2001	Stanley J. Kopecky	112703-206	3231

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BELL, BOYD & LLOYD LLC
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CHICAGO, IL 60690-1135

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

12

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,490

Applicant(s)

KOPECKY, STANLEY

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2003 has been entered.

2. This Office action acknowledges the applicant's Amendment B, presented as Paper No. 9. Claims 1-22 are pending in the application.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 1-8, 10-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranney (US 2,380,367) in view of Hachenski (US 6,138,905) and Howes (US 5,896,686).

Regarding claim 1, Ranney discloses a gum package (Figure 1) having a body (16) with a removable end wall (16'). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. End wall (16') is

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at least partially and permanently removed from the body upon separation of tear strip (21). Ranney meets all limitations claimed by the applicant except for giveaway information visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Hachenski teaches the provision of a promotion (see Col. 6, lines 20-23). Howes teaches the equivalence of a promotion and giveaway information. Hachenski discloses providing the information on the inside of the closure and only visible when the package is opened (see for example, Col. 2, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package of Ranney with giveaway information on the inner surface of the closure as taught by Hachenski and Howes in order to promote the sale of the product.

As to claim 2, the gum package of Ranney is rectangular in shape.

As to claim 3, the gum package of Ranney discloses tab and ribbon (21, as shown, Figure 1).

As to claim 4, the gum package of Ranney is constructed in part from a flexible foil.

As to claim 5, Howes discloses giveaway information adapted to inform the consumer whether or not they have won a prize.

As to claim 6, Howes discloses giveaway information concerning a contest.

As to claim 7, Hachenski discloses information printed on the inner surface.

As to claim 8, Hachenski discloses information printed on the inner surface, Hachenski does not expressly disclose stamping information on the inner surface. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes by stamping since the examiner takes Official Notice of the equivalence of stamping and printing for their use in the information providing art and the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 10, the gum package of Ranney houses a plurality of sticks of chewing gum.

Regarding claim 11, Ranney discloses a package (Figure 1) having a flexible body (16) with inner surfaces defining an interior for housing products and a removable end wall (16'). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. The removable end wall (16') is at least partially and permanently removable by grasping and pulling member (21). Ranney meets all limitations claimed by the applicant except for giveaway information visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Hachenski teaches the provision of a promotion (see Col. 6, lines 20-23). Howes teaches the equivalence of a promotion and giveaway information. Hachenski discloses providing the information on the inside of the closure and only visible when the package is opened (see for example, Col. 2, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package

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of Ranney with giveaway information on the inner surface of the closure as taught by Hachenski in order to promote the sale of the product.

As to claim 12, member (21) of Ranney is a tab.

As to claim 13, Ranney discloses grasping a tab and tearing a portion of the body to remove the end wall.

As to claim 14, Hachenski discloses information printed on the inner surface.

As to claim 15, the package of Ranney is constructed in part from a flexible foil.

As to claim 16, the package of Ranney is rectangular in shape.

Regarding claim 18, the gum package of Ranney-Hachenski-Howes as applied above discloses the claimed method by presentation.

As to claim 19, the package of Ranney-Hachenski-Howes provides a tab for tearing the package to remove the end wall.

As to claim 20, the package of Ranney-Hachenski-Howes discloses providing printing on the inner surface.

As to claim 21, the package of Ranney-Hachenski-Howes discloses providing printing on the inner surface. Ranney-Hachenski-Howes does not expressly disclose stamping information on the inner surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes by stamping since the examiner takes Official notice of the equivalence of stamping and printing for their use in the information providing art and

the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 22, the package of Ranney-Hachenski-Howes is rectangular in shape.

5. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranney in view of Hachenski and Howes as applied to claims 1 and 11 above, and further in view of Focke et al (US 5,375,704).

Regarding claim 9, the gum package of Ranney-Hachenski-Howes as applied to claim 1 above meets all limitations claimed by the applicant except for giveaway information provided on a removable insert.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

Regarding claim 17, the package of Ranney-Hachenski-Howes as applied to claim 11 above meets all limitations claimed by the applicant except for giveaway information provided on a removable insert.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

Response to Arguments

6. Applicant's arguments filed December 12, 2003 have been fully considered but they are not persuasive.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. In response to applicant's argument that Hachenski and Howes destroy one another, the test for obviousness is not whether the features of a secondary reference(s) may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The primary reference, Ranney, discloses the claimed

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invention except for the provision of the giveaway information. Hachenski and Howes teach the provision of giveaway information to promote the sales of the product. Hachenski teaches the placement of the information on the internal surface of the closure to prevent viewing until the opening of the package. One of ordinary skill in the art would have recognized that it would not be necessary to incorporate the entire closure of Hachenski (or Howes) into the package of Ranney to reap the benefits of the giveaway information.

9. In response to the applicant's arguments with respect to Focke et al, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Focke et al teaches removable printed information under the lid of a package. Further, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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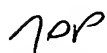
within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory Pickett
Examiner
2 April 2004


Mickey Yu
Supervisory Patent Examiner
Group 3700